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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/000,366	01/28/1998	MASAHITO HOASHI	HOASHI=2	5189

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EXAMINER	
BECKER, DREW E	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/000,366	HOASHI ET AL.	
	Examiner	Art Unit	
	Drew E. Becker	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-14 and 17-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-14 and 17-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The request filed on February 23, 2005 for an RCE based on parent Application No. 09/000,366 is acceptable and an RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3-6, 10-13, and 17-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to disclose a "weight of 1kg or more" found in claim 1. Claim 17 recites "10 kg or more". The relied upon passages simply recite that the meat is distributed "in kg units". It does not specify how many kilograms. Only the examples provide a specific value of only 10 kg. Claim 19 recites "uniform particles". However, this limitation does not appear to be disclosed in the specification. The cited passages only describe the size of the particles, and not their appearance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 3-6, 10-13, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over CA 1213170A in view of Vitkovsky [Pat. No. 4,687,672].

CA 1213170A teaches a method for thawing a frozen ground meat mass by freezing the ground meat at -40°C (page 14, line 21), comminuting the frozen meat in two steps (page 15, lines 4-20), thawing with elevated temperature and without mashing or additives (page 16, lines 15-25), comminuting to a size of 0.125-1.00" or 3-25 mm (page 6, lines 11-12), storing the mass in a plastic bag which is clearly larger than 5 cm (Figure 2, #56 & 58), and the conventional size of meat packages being 1-5 lbs (page 1, line 26). CA 1213170A does not specifically recite fish, milling at less than -15°C, or the meat mass being 10 kg. Vitkovsky teaches a method of milling frozen minced fish (column 9, line 3) to a size of 5-12 mm (column 8, line 13) by freezing it to a temperature of 0 to -196°C (column 6, line 23) and then milling the frozen minced fish (Figure 1, 10 & 35). It would have been obvious to one of ordinary skill in the art to use fish as the meat source of CA 1213170A, in view of Vitkovsky, since both are directed to methods of milling frozen meats, since CA 1213170A already teaches using "other edible animal flesh" (page 6, line 8), since fish meat is edible animal flesh, and since

Vitkovsky teaches that minced fish was commonly frozen and milled. It would have been obvious to one of ordinary skill in the art to incorporate the milling temperature of Vitkovsky into the invention of CA 1213170A since both are directed to methods of milling frozen meat, since CA 1213170A already included freezing at -40°C (page 14, line 21), and since Vitkovsky teaches that milling at low temperatures causes the food to become frangible and thus more easily milled (column 1, lines 55-60). It would have been obvious to one of ordinary skill in the art to accumulate 10 kg of the meat in CA 1213170A since CA 1213170A already disclosed storing the mass in plastic bags (Figure 2, #56), since the conventional size of meat packages being 1-5 lbs (page 1, line 26), since restaurants and other institutions used even larger packages of frozen ground meat (page 2, lines 3 and 12), and since bulk packages of 10 kg or more were commonly used in the food preparation industry in order to reduce the amount of packaging needed for a given amount of meat.

6. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over CA 1213170A in view of Vitkovsky as applied above, and further in view of Katoh et al [Pat. No. 4,950,494].

CA 1213170A and Vitkovsky teach the above mentioned concepts. CA 1213170A and Vitkovsky do not teach using a pin mixer to stir in additives such as seasoning, starch, sugar, or polyphosphate. Katoh et al teach a method of processing fish paste by mixing in seasoning and starch (column 7, line 5) by using a pin mixer (Figure 1). It would have been obvious to one of ordinary skill in the art to incorporate the mixing of Katoh et al into the invention of CA 1213170A, in view of Vitkovsky, since all are directed to

methods of processing ground meat, since Vitkovsky already included fish meat, since additives were commonly known to enhance flavor and other food properties, and since pin mixers were commonly used to add ingredients to ground meat as shown by Katoh et al.

7. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al in view of CA 1213170A, Vitkovsky, and JP 06133739A.

Katoh et al teach a method of producing kamaboko by molding thawed, ground fish paste (column 6, lines 42-51) and heating the molded fish in two steps to induce gelling (column 6, lines 53-64). Katoh et al do not teach milling frozen, ground fish meat at less than -15°C or heating with electricity. CA 1213170A teaches a method for thawing frozen ground meat by milling the frozen meat (page 15, lines 4-20), a temperature of -40°C (page 14, line 21), and thawing with elevated temperature (page 16, lines 15-25). Vitkovsky teaches a method of milling frozen minced fish (column 9, line 3) to a size of 5-12 mm (column 5, line 13) by freezing it to a temperature of 0 to -196°C (column 6, line 23) and then milling the frozen minced fish (Figure 1, 10 & 35). JP 06133739A teaches a method of producing molded fish paste products by heating with electricity (abstract). It would have been obvious to one of ordinary skill in the art to incorporate the milling of CA 1213170A into the invention of Katoh et al since both are directed to producing ground meat products, since Katoh et al already teaches thawing (column 7, line 1), and since milling prior to thawing would result in reduced thawing time due to the reduction in surface area in relation to volume as taught by CA 1213170A (page 6, lines 13-20). It would have been obvious to one of ordinary skill in the art to incorporate the

milling temperature of Vitkovsky into the invention of Katoh et al, in view of CA 1213170A, since all are directed to methods of processing meat, since CA 1213170A already included freezing at -40°C (page 14, line 21), and since Vitkovsky teaches that milling at low temperatures causes the food to become frangible and thus more easily milled (column 1, lines 55-60). It would have been obvious to one of ordinary skill in the art to incorporate the electric thawing of JP 06133739A into the invention of Katoh et al since both are directed to the processing of fish paste products, since Katoh et al already includes heating, and since electric heating was commonly known and used for fish paste products as shown by JP 06133739A.

Response to Arguments

8. Applicant's arguments filed February 23, 2005 have been fully considered but they are not persuasive.

Applicant argues that CA 1213170A does not teach a weight of 1kg. However, CA 1213170A clearly teaches storing the mass in plastic bags (Figure 2, #56), the conventional size of meat packages being 1-5 lbs (page 1, line 26), and restaurants and other institutions used even larger packages of frozen ground meat (page 2, lines 3 and 12). Furthermore, this weight in applicant's specification refers merely to the amount of meat which is processed, not to a specific "slab".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., slabs) are not recited in the rejected claim(s). Although the claims are interpreted

in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, CA 1213170A is directed to a method of thawing frozen ground meat, and Vitkovsky is directed to a method of milling frozen minced fish. It would have been obvious to one of ordinary skill in the art to combine the teachings of CA 1213170A and Vitkovsky since CA 1213170A already teaches using "other edible animal flesh" (page 6, line 8), since fish meat is edible animal flesh, and since Vitkovsky teaches that minced fish was commonly frozen and milled; since CA 1213170A already included freezing at -40 C (page 14, line 21), and since Vitkovsky teaches that milling at low temperatures causes the food to become frangible and thus more easily milled (column 1, lines 55-60).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E. Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Fri. 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Drew E Becker
Primary Examiner
Art Unit 1761